

Amendment and Response under 37 C.F.R. 1.116

Applicant: Alan C. Berkema et al.

Serial No.: 09/897,656

Filed: June 29, 2001

Docket No.: 10016784-1

Title: PORTABLE WIRELESS DEVICE AND SOFTWARE FOR PRINTING BY REFERENCE

REMARKS

The following Remarks are made in response to the Final Office Action mailed October 27, 2006, in which claims 4, 5, 9-12, 15, 18-20, 22, 32-34, and 37-45 were rejected.

With this Amendment, claim 9 has been cancelled without prejudice, and claims 15, 20, 22, 42, and 43 have been amended.

Applicant notes that claims 15, 20, 22, 42, and 43 have been amended only to change dependency and submits that these amendments do not raise new issues that would require further consideration and/or search and are within the scope of a search properly conducted under the provisions of MPEP 904.03.

Claims 4, 5, 10-12, 15, 18-20, 22, 32-34, and 37-45, therefore, remain pending in the application and are presented for reconsideration and allowance.

Claim Rejections under 35 U.S.C. § 103

Claims 4, 19, 32-34, 40, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US Patent No. 6,385,728 in view of Bluetooth as evidenced by Nordman US Publication No. 2002/0174364.

Claims 41 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US Patent No. 6,385,728 in view of Bluetooth as evidenced by Nordman US Publication No. 2002/0174364, and further in view of Ferlitsch US Publication No. 2002/0114004.

Claims 9-12, 15, 20, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US Patent No. 6,385,728 in view of Larsson WO 01/42894.

Claims 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US Patent No. 6,385,728 in view of Larsson WO 01/42894, and further in view of Atkinson US Publication No. 2002/0012329.

Claims 4, 19, 32-34, 40-41, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US Patent No. 6,385,728 in view of Larsson WO 01/42894, and further in view of Bluetooth as evidenced by Nordman US Publication No. 2002/0174364.

Claims 22 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US Patent No. 6,385,728 in view of Larsson WO 01/42894, and further in view of Ferlitsch US Publication No. 2002/0114004.

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Claims 41 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US Patent No. 6,385,728 in view of Larsson WO 01/42894 and Bluetooth as evidenced by Nordman US Publication No. 2002/0174364, and further in view of Ferlitsch US Publication No. 2002/0114004.

Claims 5, 18, and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson WO 01/42894 in view of Woo US Patent No. 6,336,074.

With this Amendment, claim 9 has been cancelled without prejudice. The rejection of claim 9 under 35 U.S.C. 103(a), therefore, is rendered moot. In addition, claim 15 has been amended to depend from independent claim 4, claims 10-12, 42, and 43 have been amended to depend from independent claim 5, and claims 20 and 22 have been amended to depend from independent claim 18.

Regarding the rejection of claims 4, 19, 32-34, 40, 41, 44, and 45 under 35 U.S.C. 103(a), Applicant notes that the earliest effective date of the Nordman U.S. Patent Application Publication No. 2002/0174364 is the filing date of May 21, 2001 which is prior to the filing date of June 29, 2001 of the present patent application.

Accompanying this Amendment and Response is a Declaration of Prior Invention under 37 C.F.R. 1.131 to establish conception of the subject matter of the present patent application in the United States prior to the earliest effective date of May 21, 2001 of the Nordman Publication coupled with due diligence from a date prior to the earliest effective date of the Nordman Publication up to the filing date of the present patent application (i.e., constructive reduction to practice). Applicant, therefore, respectfully requests consideration and entry of the Declaration of Prior Invention under 37 C.F.R. 1.131.

In view of the above, Applicant submits that the Nordman U.S. Patent Application Publication No. 2002/0174364 does not qualify as a reference under 35 U.S.C. 102(e) and, therefore, does not qualify as a reference under 35 U.S.C. 103(a). Applicant, therefore, respectfully requests that the rejections of claims 4, 19, 32-34, 40, 41, 44, and 45 under 35 U.S.C. 103(a) be reconsidered and withdrawn, and that claims 4, 15, 19, 32-34, 40, 41, 44, and 45 be allowed.

Regarding the rejection of claims 5, 18, and 37-39 under 35 U.S.C. 103(a), Applicant respectfully traverses this rejection.

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Independent claim 5 includes **"wirelessly communicate a reference to a print device, the reference identifying a location at which a print content of a content provider is located on a network and a location of a print service, wherein the reference causes the print device to retrieve the print content of the content provider from the network and to print the print content,"** and **"wherein the reference causes the print device to retrieve the print content of the content provider from the network by causing the print device to supply the reference to the print service."**

Independent claim 18 includes **"wirelessly communicate a reference to a print device, the reference identifying a location at which a print content of a content provider is located on a network, wherein the reference causes the print device to retrieve the print content of the content provider from the network and to print the print content."**

Independent claim 37 includes **"a first communication interface adapted to enable first communication between the portable wireless device and a content provider, and second communication between the portable wireless device and a print service,"** and **"a processor coupled to the first communication interface, the processor being adapted to cause the first communication interface to communicate a reference that identifies a location of a print content of the content provider to the print service."**

With respect to the Larsson and Woo references, Applicant submits that these references, individually or in combination, do not teach or suggest a computer program product as claimed in independent claim 5, do not teach or suggest a computer program product as claimed in independent claim 18, and do not teach or suggest a computer program product as claimed in independent claim 37.

For example, the Larsson reference discloses a document presentation system comprising cellular telephone 100, information service provider 200, and communication device 300a/300b for a presentation unit, such as printer 380 (page 12, lines 24-29; Fig. 1). As such, communication device 300a/300b of the system of the Larsson reference receives a document address from cellular telephone 100 and transmits the document address to information service provider 200 (page 13, line 23 - page 14, line 5). With the system of the Larsson reference, communication between cellular telephone 100 and communication device 300a/300b is conducted via short-range communication link 20 and is provided by means of a

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short-range communication interface 116 of the cellular telephone, and communication between cellular telephone 100 and information service provider 200 is conducted over wireless telephone network 14 and is provided by interface 118 of the cellular telephone (page 18, lines 7-14).

As applied to claims 5, 18, and 37-39, at pages 11-12 of the Detailed Action, the Examiner contends that:

Larsson discloses a print device (380) comprising a print service (300b), the print device distinct from a content provider (200), and a wireless device (100) wirelessly communicating a reference identifying a location (document address) at which a print content of the content provider is located on a network (pg. 24 lines 19-30 and pg. 25 lines 17-20), wherein the reference causes the print device to retrieve the print content of the content provider from the network and to print the print content (pg. 25 lines 17-20).

Thus, with the system of the Larsson reference, the Examiner contends that printer 380 represents "a print device" and communication device 300b represents "a print service." As communication device 300b of the Larsson reference receives the document address from cellular telephone 100 and transmits the document address to information service provider 200, with the Examiner's application of the Larsson reference to claims 5, 18, and 37-39, the document address is communicated to "the print service" (i.e., communication device 300b) such that "the print service" (i.e., communication device 300b) supplies the document address to information service provider 200.

With the Examiner's application of the Larsson reference to claims 5, 18, and 37-39, however, the document address is not communicated to "the print device" (i.e., printer 380), "the print device" (i.e., printer 380) does not supply the document address to "the print service" (i.e., communication device 300b), nor does "the print device" (i.e., printer 380) retrieve the print content. Accordingly, Applicant submits that the Larsson reference does not teach or suggest **"wirelessly communicate a reference to a print device"** as claimed in independent claim 5, does not teach or suggest **"wherein the reference causes the print device to retrieve the print content of the content provider from the network and to print the print content"** as claimed in independent claim 5, and does not teach or suggest **"wherein the reference causes the print device to retrieve the print content of the**

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Docket No.: 10016784-1

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content provider from the network by causing the print device to supply the reference to the print service" as claimed in independent claim 5. In addition, Applicant submits that the Larsson reference does not teach or suggest **"wirelessly communicate a reference to a print device"** as claimed in independent claim 18, and does not teach or suggest **"wherein the reference causes the print device to retrieve the print content of the content provider from the network and to print the print content"** as claimed in independent claim 18.

As applied to claim 37, at pages 12-13 of the Detailed Action, the Examiner contends that:

As per claim 37 the wireless device disclosed by Larsson comprises communicates with the content provider using a first communication interface (Larson, Fig. 6 object 118) and transmits the print content to the print device for printing with the print service using a second communication interface (Larson, Fig. 6 object 116).

Thus, with the system of the Larsson reference, the Examiner contends that communication interface 118 represents "a first communication interface" and communication interface 116 represents "a second communication interface." As outlined above, communication between cellular telephone 100 and communication device 300b is conducted via short-range communication link 20 and is provided by communication interface 116, and communication between cellular telephone 100 and information service provider 200 is conducted over wireless telephone network 14 and is provided by interface 118.

With the Examiner's application of the Larsson reference to claim 37, however, "the first communication interface" (i.e., interface 118) does not enable communication between cellular telephone 100 and "the print service" (i.e., communication device 300b), nor does "the first communication interface" (i.e., interface 118) communicate the document address to "the print service" (i.e., communication device 300b). Accordingly, Applicant submits that the Larsson reference does not teach or suggest **"a first communication interface adapted to enable first communication between the portable wireless device and a content provider, and second communication between the portable wireless device and a print service"** as claimed in independent claim 37, and does not teach or suggest **"the processor being adapted to cause the first communication interface to communicate a reference**

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that identifies a location of a print content of the content provider to the print service"
as claimed in independent claim 37.

In view of the above, Applicant submits that independent claims 5, 18, and 37 are each patentably distinct from the Larsson and Woo references and, therefore, are each in a condition for allowance. Furthermore, as dependent claims 10-12, 42, and 43 further define patentably distinct claim 5, dependent claims 20 and 22 further define patentably distinct claim 18, and dependent claims 38 and 39 further define patentably distinct claim 37,

Applicant submits that these dependent claims are also in a condition for allowance.

Applicant, therefore, respectfully requests that the rejection of claims 5, 18, and 37-39 under 35 U.S.C. 103(a) be reconsidered and withdrawn, and that claims 5, 10-12, 18, 20, 22, 37-39, 42, and 43 be allowed.

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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 4, 5, 10-12, 15, 18-20, 22, 32-34, and 37-45 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Any inquiry regarding this Amendment and Response should be directed to either Nathan Rieth at Telephone No. (208) 396-5287, Facsimile No. (208) 396-3958 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 14th day of December, 2006.

By 
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